

Appln No. 09/575,139
Amdt. Dated December 23, 2003
Reply to Office action of July 28, 2003

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REMARKS/ARGUMENTS

Thank you for the detailed Office Action in reply to my previous submission in relation to this matter.

Having reviewed the Office Action, we respectfully traverse many of the conclusions it reaches. Whilst there are a number of points upon which we believe the case presented against this application is not supported, we will limit my comments to the most relevant, given that this Action is Final.

1. Interpretation of the word "printed"

We note that you have sourced a dictionary definition showing that the word "printing" can refer to outputting to a computer screen. We agree that the word "printing", by itself, can be used in this manner. However, there are a number of difficulties with this conclusion.

1.1 The MPEP makes it clear that "claims must be 'given their broadest reasonable interpretation *consistent with the specification*.' " (MPEP 2111). This is distinct from the issue of importing meaning from the specification, which is obviously not allowed. Rather, this statement relates to what a reader of the specification would understand a word in the claims to mean in the event there are a number of alternative interpretations available (see the rest of MPEP 2111). For example, the word "seat" in the context of a valve seal has a meaning completely different to that in a furniture context, and it is only reasonable that the broadest interpretation of the word "seat" in a claim be limited to the field of art of the specification.

In the present case, the entire specification relates explicitly and exclusively to printing in the context of outputting relatively permanent marks onto a substrate. Typically, the marks are made with ink or dye, and the substrate is paper or cardboard, but the concept of this type of "printing" is well known and understood to those skilled in the printing art. Interpreting the word "printing" as including outputting to a computer display is not consistent with the field of art to which the specification is directed. Such an interpretation is therefore, it is submitted, inconsistent with the specification, and should be withdrawn.

1.2 "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that *those skilled in the art* would reach" (MPEP 2111). In the present case, it is abundantly clear that the field of art is that of the interaction between printed matter and a sensing device. For your convenience, we quote the opening paragraph of the specification:

"The present invention relates generally to methods, systems and apparatus for interacting with computers by means of *printed matter and sensing devices*. More particularly, the invention relates to delivery of a facsimile, utilizing such methods, systems and apparatus."

The rest of the specification supports this by being solely concerned with the provision of a system that is based on printed matter as described earlier in this response. For example, you will note that there is no disclosure of using a computer screen for interaction in the way disclosed in Merchant. Please note that we am not suggesting that a lack of disclosure of

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such a mechanism in some way means that the claims, per se, should be limited with reference to the description. Rather, we are making the point that the field of art is quite clearly and exclusively that involving the physically printed matter described above. As such, we respectfully submit that the interpretation of "printing" you have presented is inconsistent with what one skilled in the art would interpret the word to mean.

1.3 You have used a dictionary to find an interpretation of "printing" to support your contention about outputting to a computer screen. However, this conclusion requires the assumption that the word "printing" is used in isolation, which is not the case in the claims. The full phrase used is "utilising a form printed *onto* at least one surface". We strongly submit that no-one, and particularly no-one skilled in the art, could read this phrase as reasonably including outputting to a computer screen. To argue the contrary is to suggest that one skilled in the art would use a phrase such as "reading a jpeg from a disk-drive and printing it *onto* a computer monitor screen". We submit that this is clearly language that would never be used by one skilled in the art.

For all of these reasons, we respectfully submit that your conclusion in relation to the "printed" nature of the displayed form in Merchant is not supportable, and should therefore be withdrawn. Please note that, in the event this matter is again rejected and goes to appeal, we will be providing ample declarations from suitably qualified experts in support of my comments above.

2 Coded Data

I note that you have concluded that the bubbles in Merchant are "coded data" as defined in the present claims, because they are indicative of the fact that the form is a fax form. We respectfully disagree with this conclusion.

The claims require that the coded data be "indicative of an identity of the form and a position of the sensing device relative to the area". In Merchant, the bubbles you have referred to are simply markers indicating where numbers should be entered using a stylus. On this basis, the bubbles are not "coded data" and are not indicative of an identity of the form.

Regarding the data being coded, in what way can it be said that a circle drawn on a form is "encoded"? It is simply a circle, and is in no way encoded according to any meaning of the word "coded" of which we are aware. No-one skilled in the art would interpret the word "coded" to include a simple circle unless the circle was intended to mean something else.

Regarding the bubbles being indicative of an identity of the form, there is no disclosure in Merchant of the coded data (=bubbles) being indicative of an identity of anything. You have suggested that "the 'bubbles' are indicative of a fax form". We respectfully disagree. Taken by themselves, the bubbles are indicative of nothing. In the context of the entire form being presented, a user would interpret them as being indicative of a space to enter a fax number. In no way can it be said that the bubbles are coded data indicative of an identity of the form.

In short, even if there is disclosure of a general class of form (ie, a fax form) in Merchant, there is certainly nothing to suggest that this class is in any way tied to the actual bubbles displayed on the screen, let alone that the bubbles encode data to this effect. There is no way of interrogating the bubbles to determine information they encode, such as the identity of the document.

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For these reasons, it is submitted that the independent claims are allowable.

3 *Patentable Weight*

You mention that the features mentioned above are part of the preamble and are therefore not given patentable weight. However, these features do not merely "[recite] the purpose of a process", as you suggest; rather, they are actual limitations that must be present in a claim for it to be infringed. Removing references to these features would render the claims meaningless. As such, the claimed steps depend directly on them for completeness, and these features must by definition add patentable weight to the claims.

Should you wish to maintain this rejection, we would greatly appreciate your comments on why these features should not be given patentable weight in light of this submission.

4. *"Sensing" Device*

I am at something of a loss to understand your comments in relation to the stylus in Merchant anticipating a "sensing device" as claimed.

For a start, you have defined a "sensing device" as one which "touches", simply because the word "sense" can include the sense of "touch within its scope. With respect, this is a gross misinterpretation of the words as plainly presented in the claim.

"Sensing", used as a verb, indicates information being received by a sensor. For example, the human sense of "vision" involves *receiving* visual information and the human sense of "touch" involves *receiving* tactile information.

The present claims define a "sensing device". Since "sensing" means "receiving information", it must therefore follow that a "sensing device" is one that receives information. You have identified the stylus in Merchant as being the "sensing device", yet it clearly has no such function. The function of the stylus in Merchant is to allow information to be input onto the touch-screen, which is the real "sensing device" in Merchant.

In short, to suggest that a passive stylus is a "sensing device" on the basis of your interpretation goes far beyond any reasonable interpretation of the plain language in use. Should you wish to maintain this rejection, we respectfully request that you provide evidence that the phrase "sensing" can ever be interpreted in the way you suggest, particularly since it seems to be the opposite of the plain meaning of the word.

My other difficulty with your conclusion at this point is that even allowing for your interpretation of "sensing device", it is utterly clear that this feature in Merchant does not function in the manner defined in the present claims. Claim 1, for example, requires that the interaction data (as defined) is generated by the sensing device and (implicitly) output for reception in the computer system. As mentioned above, the sensing device in Merchant is a passive stylus – how can it be said to generate the interaction data and output it for reception by the computer system? Moreover, how can the passive sensing device in Merchant reasonably be said to "[sense] at least some of the coded data in the vicinity of the position", as defined in the claims?

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Conclusion

There are a number of issues in relation to the other claims that we believe can be argued, but we have decided to concentrate in this response on the independent claims. Accordingly, we submit that the dependent claims are patentable in view of their dependence on allowable base claims, without prejudice in relation to the independent allowability of the dependent claims.

Further consideration of the present application is respectfully requested.

Very respectfully,

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